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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,355	11/07/2001	Mitchell D. Eggers	GENV-002/00US 300805-2003	3570

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EXAMINER	
ALEXANDER, LYLE	

ART UNIT	PAPER NUMBER
1797	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/007,355	EGGERS, MITCHELL D.	
	Examiner	Art Unit	
	Lyle A. Alexander	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40 and 58-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40 and 58-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The Examiner acknowledges receipt of the lengthy information disclosure statement filed March 24, 2009. There is no requirement that applicants explain the materiality of English language references, however the cloaking of a clearly relevant reference in a long list of references may not comply with applicants' duty to disclose, see Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, aff'd 479 F. 2d. 1338. There is no duty for the Examiner to consider these references to a greater extent than those ordinarily looked at during a regular search by the Examiner. Accordingly, the Examiner has considered these references in the same manner as references encountered during a normal search of Office search files.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-40 and 58-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 7,142,987. Although the conflicting claims are not identical, they are not patentably distinct from each other because even though the patented claims are directed to a method and the instant claims are directed to a sample carrier, it would have been

within the skill of the art performing the claimed method to use a sample carrier that is indistinguishable from that presently claimed. Furthermore, the instant application is not related as a divisional of the '987 patent that would have precluded this rejection.

Claims 1-40 and 58-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 115-121,134-137,148-150,158-165 of copending Application No. 10/150,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a sample carrier comprising a structural array having a plurality of node, optically labeled identification means and means to control/locate each sample.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-40 and 58-69 are rejected under 35 U.S.C. 102(b as being clearly anticipated by WO 96/11046.

WO 96/11046 describes on pages 18-19 an apparatus(100) for tracking a processing biological samples. The apparatus(100) comprises identification station(101), tracking station(102) and processing station(103). Biological sample are deposited and dried a sample card(104). Each card(104) has identifying indicia(106). Each card(104) containing a dried sample is placed in a stacker(107). Tracking

station(102) removes a portion of the sample from card(104) and the removed sample portion is received by a container that will be processed by station(103). Page 7 lines 6 and 27 teach polystyrene and cellulose as a suitable sample support material. Further, page 18 lines 19-23 teach cellulose, paper and filter paper are preferred substrates. Page 10 line 26 teaches the substrate surface can be "derivatized."

The Office has read the claimed "structural array" on the taught stacker(107). The Office has interpreted "discrete" as "a separate entity, or a combination of distinct and unconnected elements." The Office has read the taught card(104) on the claimed "a plurality of discrete sample node." The Office maintains each card(104) is "discrete" because each card(104) is a separate entity that is unconnected to other cards(104). Further, the taught transfer of the card(104) from the stacker(107) to the identification station(101) has been read on the claimed "... nodes being removably attached to said structural array ...". Finally, because WO 96/11046 teaches all of the claimed support materials, the Office maintains these materials would inherently meet the claimed limitations of the support being positively or negatively charged.

Response to Arguments

Applicant's arguments filed 3/2/09 have been fully considered but they are not persuasive.

Applicants' correctly state application 10/005,529 has matured into USP 7,142,987. Applicants' further state in the prosecution of the 987' patent there was a restriction made between the method and apparatus claims. Applicants' state the 987'

patent issued the method claims which should be free of any obviousness type of double patenting issues because of the restriction made in the 987' patent. The Office maintains this logic will only apply in the situation of a divisional application. The pending application is not a divisional of the 987' patent and the obviousness type double patenting rejection is proper.

The 12/29/08 Decision by the BPAI affirmed a previously made 35 USC 103 rejection of claims 15-19, 36-40 and 67-68 over Hogan. However, the BPAI reversed the 35 USC 102(e) of the claims 1-14, 20-35, 58-66 and 69 over the same Hogan reference. The affirmed claims are dependent upon the claims the BPAI said was free of Hogan. The BPAI did not provide any guidance on how to properly apply the 35 USC 103 rejection in light of the facts the independent claims are free of Hogan. However, Applicant has supplied a superior reference, WO 96/11046, in their 3/24/09 IDS that clearly anticipated all of the pending claims under 35 USC 102(b). The Office has vacated the 35 USC 103 rejections over Hogan that were affirmed by the BPAI in favor of this new superior rejection of all the claims under 35 USC 102(b).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Natan et al. (USP 7,225,082) teach a nano particle that is labeled with a bar code and functionalized. Column 3 lines 16-38 teach the fuctionalized portion of the particle can be made of polymers or glass. The functional portion is coated with a binding molecule such as an antibody or antigen. Columns 4-5 lines -20 teach the use of

nanobar codes to identify teach particle. Each particle is placed in a microtiter plate. This references fails to teach an apparatus capable of processing samples that are desiccated.

Chang et al. (USP 6,350,620) teach a microcarrier comprising a bar code and a binding molecule. Column 2, lines 56-62 teach the microcarrier can be made of glass, cellulose, organic polymers, etc. Column 2 lines 63-65 teach the binding molecules can be nucleic acids, antigens, antibodies, etc. Columns 3-4 lines 51-10 respectively teach the use of the appropriate number of individual containers and microcarriers to determine the corresponding number of biomolecule. This references fails to teach an apparatus capable of processing samples that are desiccated.

Mandecki (USP 5,981,166) teaches a bioassay for the rapid screen of compounds by delivering the compounds to transponders or tag that are coated with the appropriate reactants. Column 2-3 lines 50-4 respectively teach coating the transponder with a polymer layer that contains the desired chemical compound. The transponder is also encoded with a unique serial number that will identify the compound. The transponder is placed in a well of a microtiter plate where the chemical compound is dispersed. Column 4 lines 44-describe the methods of encoding the transponder which includes a bar code. Columns 5-6 lines 53-4 respectively teach the transponder can be made of silicon dioxide and coated with a plastic material. This references fails to teach an apparatus capable of processing samples that are desiccated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1797

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